

Application No. 09/713,228

AMENDMENTS TO THE DRAWINGS

Amendments have been made to the drawings to correct minor typographical errors. In particular, FIG. 6 has been amended to change "Assignmant" to "Assignment," and FIG. 12 has been amended to change "Selectoion" to "Selection." No new matter has been added.

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REMARKS

Claims 1-3, 6-8, 10-13, 16-18, 21-27, 29, 30, 32, and 33 are pending. By this amendment, claims 1, 17, and 29 are amended, and no claims are canceled or added.

Claims 1 and 29 are amended to more precisely define the nature and scope of the invention. In particular, claims 1 and 29 are amended to recite display(ing), on the terminal computer of the potential buyer, a page for designating a display position and a display size of the advertisement on the article as the advertisement will be displayed during the contest when the article is visible to an audience, in combination with the other elements respectively recited in the claims. Support for the amendments can be found in the application as filed at, for example, page 11, line 27 – page 12, line 27; page 15, line 10 – page 16, line 19; page 17, line 3 – page 18, line 13; page 20, line 26 – page 21, line 11; page 23, line 11 – page 25, line 31; and FIGS. 1, 3, 9, 10, and 12. Claim 17 has been amended to remedy a minor typographical error. Accordingly, no new matter has been added to claims 1, 17, and 29 by the amendments.

Claim Rejections – 35 U.S.C. § 103

Claims 1, 2, 6, 8, 10-12, 16, 17, 24, 25, and 29 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,487,538 to Gupta et al. (hereinafter Gupta) in view of U.S. Patent No. 6,470,079 to Benson (hereinafter Benson) and further in view of U.S. Patent No. 6,254,478 to Namanny et al. (hereinafter Namanny). Claims 3, 7, and 30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Gupta in view of Benson, further in view of Namanny, and further in view of U.S. Patent No. 6,324,519 to Eldering (hereinafter Eldering). Claims 13, 22, and 23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable

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over Gupta in view of Benson and further in view of Namanny. Claim 18 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Gupta in view of Benson, further in view of Namanny, and further in view of U.S. Patent No. 5,970,471 to Hill (hereinafter Hill). Claim 21 stands rejected under 35 U.S.C. § 103 (a) as being unpatentable over Gupta in view of Benson, further in view of Namanny, and further in view of U.S. Patent No. 6,253,189 to Feezell et al. (hereinafter Feezell). Claims 26 and 32-33 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Gupta in view of Benson, further in view of Namanny, further in view of Feezell, and further in view of U.S. Patent No. 5,892,554 to DiCicco et al. (hereinafter DiCicco). Claim 27 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Gupta in view of Benson and further in view of Namanny.

Insofar as the rejections apply to the amended claims, the rejections are respectfully traversed.

First, it is respectfully submitted that a *prima facie* case of obviousness has not been established. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP §§ 2142, 2143.

Applicant respectfully submits that there is no motivation to combine the cited references as suggested in the Office Action. In particular, with respect to the suggested combination of Gupta and Benson, Gupta teaches away from such a combination. At column 2,

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lines 2-5, Benson discloses that "the invention provides a telecommunications environment configured to monitor information related to caller traffic responding to advertising campaigns." Benson goes on to state that the "calls [are] placed by a caller in response to an advertising campaign" and a "switch monitors calling information . . . [that] includes the directory number of the party placing the call" Col. 2, lines 11-18. Gupta, however, teaches away from the suggested combination with Benson at column 5, lines 17-43, by distinguishing advertising schemes that rely "on information retrieved from the user (which may be modified by the user) or attempts to guess information about the user," including schemes that "attempt to guess the geographic location of a user based on the client's internet protocol address" and "a correspondence between each IP address to a modem phone number."

There is also no motivation to combine the references as suggested in the Office Action with respect to Namanny. Namanny is directed to a method of conducting a competition utilizing a slotless-micro-race-track system and remote control motorized racing vehicles (Abstract). "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." MPEP § 2143.01 (citing *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990) (emphasis in original)). Applicant respectfully submits that the Office Action does not identify a suggestion or motivation in any of Gupta, Benson, or Namanny to combine the references to meet claim 1 or 29.

Even if combined as suggested in the Office Action, the cited references do not teach or suggest all of the claim limitations. Amended claims 1 and 29 recite display(ing), on the terminal computer of the potential buyer, a page for designating a display position and a display

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size of the advertisement on the article as the advertisement will be displayed during the contest when the article is visible to an audience, in combination with the other elements respectively recited in the claims. Referring, for example, to page 11, lines 27-29, of the present application as filed, "logo marks 8 displayed on the trunks 5, the flags 6 and the ornamental apron 7 are displayed frequently on the terminal 30 while broadcasting the sumo." Referring also, for example, to FIG. 1, logo marks displayed on trunks 5 or flags 6 are visible to an audience in the stadium 1 and an internet broadcast audience (page 5, lines 28-30) or normal television audience (page 26, lines 8-9).

None of the cited references, alone or in combination, teach or suggest a page for designating a display position and a display size of the advertisement on the article as the advertisement will be displayed during the contest when the article is visible to an audience in combination with the other limitations recited in each claim 1 and 29, respectively. Gupta teaches local advertising on the internet (col. 5, lines 66-67). Benson teaches a system and method for real-time reporting of advertising effectiveness (Title). Namanny teaches motorized racing vehicles "covered with a removable/replaceable plastic protective covering" that "allows easily changing trademark etc. materials visible on said motorized racing vehicles." Col. 6, lines 39-52. None of the cited references teach or suggest a page for designating a display position and a display size of the advertisement on the article as the advertisement will be displayed during the contest when the article is visible to an audience, in combination with the other elements recited in claims 1 and 29, respectively.

Claims 1 and 29, respectively, also recite "transmit[ing] to a terminal computer of a potential buyer an indicator of advertising effectiveness for the contestant, the indicator

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representing at least one of the following characteristics: achievements, popularity, ability, talent, audience rating and sales amount of the contestant," in combination with the other elements recited in the respective claims. None of the cited references teach or suggest transmitting an indicator that represents at least one of the characteristics of achievements, popularity, ability, talent, audience rating and sales amount of a contestant. The Office Action states that Gupta does not specifically teach that said television or on-line program include a contest, thus Gupta also does not teach or suggest a contestant. Benson is also silent as to a contest or a contestant. Namanny is directed to a method of conducting a competition utilizing a slotless-micro-race-track system and remote control motorized racing vehicles (Abstract), but does not teach or suggest, with respect to a contestant, any indicator that represents at least one of the characteristics of achievements, popularity, ability, talent, audience rating and sales amount, or transmitting such an indicator. Thus, none of the cited references teach or suggest "transmit[ting] to a terminal computer of a potential buyer an indicator of advertising effectiveness for the contestant, the indicator representing at least one of the following characteristics: achievements, popularity, ability, talent, audience rating and sales amount of the contestant," in combination with the other elements respectively recited in claims 1 and 29.

Therefore, claims 1 and 29 are allowable at least for the reasons set forth above. Claims 3, 6-8, 10-13, 16-18, 21-27, 30, 32, and 33 variously depend from claim 1 or 29 and are therefore also allowable. The various rejections of claims 3, 6-8, 10-13, 16-18, 21-27, 30, 32, and 33 are traversed but not expressly argued in light of the allowability of the underlying base claims.

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Conclusion

In view of the foregoing, it is submitted that this application is in condition for allowance. Favorable consideration and prompt allowance of the application are respectfully requested.

The Examiner is invited to telephone the undersigned if the Examiner believes it would be useful to advance prosecution.

Respectfully submitted,



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